

REMARKS

Claims 1-30 are pending in the instant Application, as evidenced by the enclosed copy of the filing receipt, and as noted in the Examiner's Office Action Summary sheet for the present Office Action.

By this Office Action, the Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claims 1-20 and 33, drawn to antisense compounds targeted to KSR RNA.
- II. Claims 21-31, drawn to a method of inhibiting the expression of KSR.
- III. Claim 32, drawn to a method of identifying compounds or agents that inhibit KSR mRNA.

Applicants respectfully assert that the Examiner's claim numbering in the Restriction Requirement is incorrect and submit that the Groups should properly correspond to the claims as filed as follows:

- Group I, drawn to antisense corresponds targeted to KSR RNA, claims 1-20 and 30;
- Group II, drawn to a method of inhibiting the expression of KSR, claims 21-28; and
- Group III, drawn to a method of identifying compounds or agents that inhibit KSR mRNA, claim 29.

Responsive to the Requirement for Restriction, and in view of Applicants above comments, Applicants elect to prosecute the invention of Group II, with traverse, claims 21-28, drawn to a method of inhibiting the expression of KSR. Applicants respectfully assert that claims 21-28 correspond to methods of inhibiting the expression of KSR, Group II, and request the Examiner accept this response, election and elected claim numbering as proposed.

The Examiner notes that claims 6-8 specifically claim antisense selected from a group of various nucleotides. He asserts that one (1) antisense sequence is considered to be a reasonable number of sequences for Examination and, accordingly, Applicants are required to elect one (1) antisense sequence from claims 6-8. In as much as Applicants have above elected Group II, claims 21-28, Applicants assert that a requirement, if any, for sequence species election upon election of Group II, claims 21-28, is unclear from the Examiner's remarks. An attempt to clarify this directly with the Examiner by telephone was unsuccessful. To the extent that Applicants elect claims 21-28 of Group II, which do not include claims 6-8 and are not dependent from any of claims 6-8, Applicants therefore have not set out any sequence species election.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

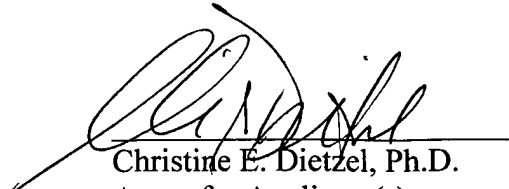
Applicants respectfully submit that the groups designated by the Examiner fail to define compositions and methods, with properties so distinct as to warrant separate Examination and Search. Applicants underscore their above arguments with regard to the proper correspondence of claims to inventive groups. Applicants further submit that Claim 29 of Group II is drawn to a method of identifying compounds or agents that inhibit KSR mRNA that are fundamentally related to Claims 21-28 of Group II, drawn to a method of inhibiting the expression of KSR. The search for any of the methods separately classified by the Examiner as the invention of Group III would require an additional search of the identical classes wherein the methods of Group II are classified, thus resulting in a duplicate search for the same material. Thus, Applicants submit that the Search of at least Group III with Group II can be made without serious burden, and therefore request that the Examiner examine the claims of Groups II and III of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of the Claims of Group II and Group III would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group II and Group III is in order.

No fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In view of the above, withdrawal of the Requirement for the Restriction is requested, and an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



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